REMARKS

Claims 1-14 currently are pending. Claims 2-3 and 5-10 currently have been amended. Claims 11-14 are new. Claim 4 has been canceled.

Claims 1-10 are rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 7, the examiner believes it is not clear if B is in "dissolved form" in liquid A or another liquid. In response, applicants point out that the term "in dissolved form" refers to a solution of substance B in a suitable solvent as can be seen from page 14, first paragraph. It is clear that substance B is not dissolved in liquid A since per definitionem substance B is not soluble nor even miscible with liquid A.

The examiner stated that it is not clear what is meant by "aqueous liquids." In response, applicants point out that the term "aqueous liquids" is well-understood by one of ordinary skill in the art. It refers to liquids that contain water as a main constituent. A definition of aqueous liquids is given on page 15, lines 23ff.

Applicants amend "obtainable" to "obtained" in claim 10.

Claims 1-10 are rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. The examiner said page 4, line 18 states that B is immiscible or soluble to less than 0.1 g/l, but claim 1 states that both of these are true about B.

In response, applicant amend claim 1 to recite "or."

Claims 1-10 are rejected under 35 USC § 103(a) as being unpatentable over EP 1206976

because the examiner believes that even though '976 fails to teach the g/m2 amount of the application, it would have been obvious for one of ordinary skill in the art to have optimized the application amount by routine experimentation.

To establish *prima facie* obviousness, the examiner must show in the prior art some suggestion or motivation to make the claimed invention, a reasonable expectation for success in doing so, and a teaching or suggestion of each claim element (*see, e.g., In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992); *In re Merck & Co., Inc.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); *In re Royka,* 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). The examiner has not met these requirements

The present application is based on the finding of the inventors that coating a rough surface (i.e., a surface having many depressions and/or elevations in a specific size range) with a liquid coating (i.e., substance B) provides a surface to which a liquid A that is immiscible with substance B has only low adhesion.

EP 1206976 teaches a rough surface which has been hydrophobized. Paragraphs 0020 and 0021 mention polymeric hydrophobizing agents. These polymeric compounds are of course solid and not liquid. EP 1206976 mentions that hydrophobizing agents might be liquid (see paragraph 0023, silicon oil, or paragraph 0028). However, this document does not disclose that the liquid compounds must have a kinematic viscosity < 10000 mm^2/sec at 20°C. Moreover, this document does not disclose that the liquids per se are useful for hydrophobizing the surface. In fact, EP 1206976 discloses only hydrophobizing coatings that are solid. In case a liquid hydrophobizing agent is used, this agent is hardened after coating as can be seen from the

working examples and likewise from paragraph 19, where it is stated that the surface might be tempered after hydrophobizing. This is not astonishing since EP 1206976 is not concerned with preparation of new hydrophobic coatings but with the use of an apparatus having a known low-adherent coating in the preparation, transport or storage of aqueous polymer dispersions.

In contrast thereto, the present invention is concerned with the preparation of a new type of coating, said coating comprises a liquid metal having a kinematic viscosity of < 10000 mm^2/sec which is coated on a rough surface. It is apparent from the foregoing that EO 1206976 disclose these.

EP1206976 does not give a hint that the application of a liquid substance having a kinematic viscosity < 10000 mm^2/sec imparts low adhesion properties to rough surfaces. As outlined above, EP 1206976 is not concerned with the preparation of new types of coatings. In fact, the coatings of EP1206976 are conventional, i.e., EP1206976 makes use of known hydrophobized surfaces. Since at that time prior art knew only low adhesive surfaces which, in the state of low adherence, comprise a solid hydrophobizing agent a skilled person would not have taken a liquid coating into account. Therefore, EO 1206976 does not motivate one of ordinary skill in the art to provide a surface according to the present invention. In order to complete the PTO's *prima facie* case and shift the burden of going forward to applicant, there must be evidence (other than speculation by the PTO) that one of ordinary skill in the subject art would have been motivated to make the modification of the prior art necessary to arrive at the claimed subject matter. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941, 1944 (Fed. Cir. 1992).

Applicants request a two months extension of time.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 14-1437. Please credit any excess fees to such deposit account.

Respectfully submitted,

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